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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,503	10/27/2000	NORIKO ITO	PF-2670/NEC/US/mh	3617

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EXAMINER
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VU, NGOC K

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/697,503

Applicant(s)

ITO, NORIKO

Examiner

Ngoc K. Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 and 35-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-21 is/are allowed.
- 6) ☒ Claim(s) 35-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/15/05</u> . | 6) <input type="checkbox"/> Other: _____  |

***Allowable Subject Matter***

1. Claims 1-21 are allowed.

The following is an examiner's statement of reasons for allowance: the closest prior art, Kitsukawa et al. (US 6,282,713 B1) teaches receiving both program and advertising data and displaying both program and advertising data if user selects an advertisement mode, and storing the advertising data for viewing later if user select a stored advertisement mode.

Kitsukawa fails to teach or fairly suggest the limitations "the control unit also generating as an output reproducing instructions based on the operator input; a reproducing unit that receives as inputs the combined output from the receiving processing unit and the operator-selected advertisement information and reproducing instructions from the control unit" as recited in claim 1.

2. The indicated allowability of claims 35-38 is withdrawn in view of the Kitsukawa reference and the newly discovered reference to Campbell, Jr. Rejections based on the newly cited reference(s) follow.

***Claim Objections***

3. Claim 35 is objected to because of the following informalities: it seems that the terms "at least one selected portion" in lines 14-15 refer to "at least one selected portion of the advertisement information". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 35-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 35 is indefinite because there is no antecedent basis for the limitation "the current broadcast program and advertisement information" in lines 19-20.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 35 is rejected under 35 U.S.C. 102(e) as being anticipated by Kitsukawa et al. (US 6,282,713 B1).

Regarding claim 35, Kitsukawa teaches a system for selectively experiencing broadcast program and advertisement information (see abstract) comprising:

receiving means (20 and 24) for receiving a broadcast stream that includes both program information and advertisement information (see col. 5, lines 19-27 and figure 3), generating a combined stream that includes both the program information and the advertisement information as they are broadcast (for displaying the advertising information along with the television program broadcast – see col. 7, lines 27-40), and generating an ad-only stream that includes only the advertisement information (for storing and displaying the stored advertising information later – see col. 7, lines 45-54);

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storage means (51) for receiving the ad-only stream and storing the advertisement information contained therein (see figure 3 and col. 5, lines 44-46);

control means (29) for fetching at least one selected portion of the advertisement information stored in the storage means in accordance with user input (via 39 & 40 or remote controller – see col. 5, lines 58-67), and sending the at least one selected portion with a control signal in accordance with the user input (for example, when the user wishes to display advertising information on the screen, CPU 29 sends a control signal to DRAM 25a of decoder 25 for subsequent output to the screen – see col. 6, lines 5-18); and

producing means (26-28 and 30-31) for producing final output that can be at least one of heard and viewed by the user, wherein the final output is either the combined stream representing the current broadcast program and advertisement information or at least one selected portion of the advertisement information as determined by the control signal from the control means (the user selects either an advertisement mode or a stored advertisement mode, the CPU processes certain data to control the generation of the advertising information along with the television program or storing of the advertising information for presentation at a later time – see col. 5, line 55 to col. 6, line 18; col. 6, line 65 to col. 7, line 13; col. 7, lines 27-38 and 45-49).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitsukawa et al. (US 6,282,713 B1).

Regarding claim 36, Kitsukawa teaches that the broadcast stream received by the receiving means is digital and the ad-only stream is digital (see col. 5, lines 12-16 and 29-31). Kitsukawa does not teach the combined stream is analog. Official Notice is taken that broadcasting data or signal in analog format is well known in the art. Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify the system of Kitsukawa by distributing data or signal in analog format to accommodate different receivers of a plurality of the users.

Regarding claim 37, Kitsukawa teaches that the at least one selected portion (i.e., CPU formulates the format and other digital data which forms the associated information on the screen) sent from the control means to the producing means is sent digitally (see col. 6, lines 13-18).

10. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitsukawa et al. (US 6,282,713 B1) in view of Campbell, Jr. (US 5,396,624 A).

Regarding claim 38, Kitsukawa teaches the storage means (51) (see figure 3). Kitsukawa does not teach the storage means is arranged as a memory stack and oldest advertisement information stored at a bottom of the memory stack is disposed of if the memory stack is full when it is time to add a new the advertisement information. However, Campbell teaches that a memory is broken into a number of stacks so that the stacks operates in a push down manner and wherein the newest entry is added at the top of the stack and the last entry is dropped off the bottom of the track. When the list is full, the oldest entry can be deleted to make room for the most current entry (see col. 7, lines 45-52 and col. 5, lines 56-58). Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify the system of Kitsukawa by storing data in memory stack so that the most recent data is

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on a top of memory stack and deleting the oldest data when the memory stack is full as taught by Campbell in order to easily update data and make room for the newest data.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 571-272-7306. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ngoc K. Vu  
Primary Examiner  
Art Unit 2611

November 16, 2005